IN THE

Supreme Court of the United States

OCTOBER TERM, 1946.

No. 717.

EDWIN B. H. TOWER, JR.,

Petitioner,

vs.

WATER HAMMER ARRESTER CORP.,

Respondent.

PETITIONER'S REPLY.

Respondent's so-called "Restatement of the Facts" is not a "*re*statement" nor is it "*of the facts.*" All the facts necessary to a consideration of the simple question presented by the petition are adequately set forth in the petition. We are confident that this Court will not be prejudiced in its consideration of that question by any such unwarranted innovation by the respondent.

The argument that the decision of the courts below upon the merits supports the jurisdiction of those courts to make that decision is but the common fallacy known as "begging the question."

Both parties being citizens of Wisconsin, the District Court usurped the function of the courts of that State when it attempted to grant relief upon a claim arising out of an alleged breach of the attorney-client relationship.

To seek a declaration that a patent is void because obtained by fraud is a function of the Attorney General of the United States which cannot be usurped by a private party.

Respondent Does Not Distinguish the Case at Bar From McCurrach v. Cheney But Only Emphasizes the Existence of Conflict.

Respondent vainly attempts to make it appear that there is no conflict between the decision in this case and the decision of the Court of Appeals for the Second Circuit in *McCurrach* v. *Cheney* (Respondent's Brief, p. 12, *et seq.*)

First, the respondent says (Brief, p. 12) that the *McCurrach* case supports petitioner's "Question Presented" and then, as though to detract from the force of its concession, respondent says (Brief, p. 14) that the *McCurrach* case "*seemingly* turned on power or jurisdiction." (Emphasis supplied.)

That the decision in the *McCurrach* case turns squarely on jurisdiction and on no other ground is emphasized by the concurring opinion of Judge Clark (152 F. (2) 367). Obviously, Judge Clark would not have protested against placing the result on the ground of lack of jurisdiction if the majority of the Court did not, in fact, do so.

In its futile attempt to distinguish the *McCurrach* case, respondent further says (Brief, p. 15) "but in view of the absence from the case of any compelling reasons for inquiring into validity, it cannot be said to be the same in character as the instant one." Indeed! In the *McCurrach* case, the complaint prayed for a judgment of invalidity (152 F. (2) 366). In the case at bar, respondent argues that such a prayer constitutes a compelling reason (Brief, pp. 4, 6).

In the *McCurrach* case, there was a disclaimer of infringement by the defendant which was held to deprive the

court of jurisdiction to proceed further. McCurrach appealed from that decision, insisting that it was entitled to a judgment of invalidity. When a prayer for relief is so persistently pursued, that, by respondent's own argument, is a most compelling reason for granting it.

Thus, in the *McCurrach* case, relief was denied on the ground of lack of jurisdiction; in the case at bar, the same relief was granted, notwithstanding petitioner's objection to jurisdiction.

Federal Courts Have No Discretion to Disregard the Constitutional Limitation Upon Their Jurisdiction.

Throughout its brief, respondent seeks to make it appear that the trial court's assumption of jurisdiction in this case is a matter of discretion. The requirements of case or controversy, imposed by the Constitution, are no less strict in actions under the Declaratory Judgments Act than in the case of other suits. Respondent naively ignores the difference between "discretion" and "jurisdiction." That there is a vital distinction is too plain for argument.

Respondent attempts (Brief, p. 10) to justify the trial court's assumption of jurisdiction in this case as an act of discretion in following the admonition of this Court in *Sinclair Co.* v. *Interchemical Corp.*, 325 U. S. 327, 330, in which this Court indicates that it is the better practice in patent cases to inquire fully into validity because of the public importance of such questions.

But surely, this Court does not in the *Sinclair* case advise the lower courts to render decisions in matters beyond the scope of their jurisdiction. The *McCurrach* case was decided subsequently to this Court's decision in the *Sinclair* case (as indicated by Judge Clark's reference to it, 152 F. (2) 368). It is plain, therefore, that the Court of Appeals for the Second Circuit does not construe the de-

cision of this Court in the *Sinclair* case as an authorization to exercise discretion to disregard the jurisdictional limitation imposed by the Constitution and by the Declaratory Judgments Act.

That a declaration of invalidity of a patent may be desirable in the public interest, does not justify a Federal Court in assuming jurisdiction to make such declaration where there is no actual case or controversy before the Court.

CONCLUSION.

Respondent's brief serves only to emphasize the existence of the conflict of decisions upon which the allowance of the petition is prayed. This Court should grant the writ to resolve that conflict.

Respectfully submitted,

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Counsel for Petitioner.